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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,756	12/03/2003	Frederick James Diggle III	030579	4220
26285	7590	07/29/2004	EXAMINER	
KIRKPATRICK & LOCKHART LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222			NGUYEN, CHAU N	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,756

Applicant(s)

DIGGLE ET AL.

Examiner

Chau N Nguyen

Art Unit

2831



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4/04 & 2/19/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of the cross-sectional geometry of the axial passageway through the first end portion increasing linearly in area in a direction away from the second end portion as claimed in claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled

“Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Scism (1,000,043).

Scism discloses a device (Figs 4-7) comprising an elongate member having a first end portion (12) and a second end portion (11) adjacent the first end portion, the elongate member defining an axial passageway for receiving a cable therethrough, and wherein the axial passageway has a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway (re claim 1). Scism also discloses the cross-sectional geometry of the axial passageway being circular (re claim 2), the second end portion comprising a first threaded portion (means for removably engaging a raceway member, re claim 20) and the raceway member comprising a second threaded portion, and wherein the second end portion may threadingly engage the second threaded portion of the raceway (re claim 3). In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

4. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Stout, Jr. (6,548,760).

Stout, Jr. discloses a device (Fig. 5) comprising an elongate member defining an axial passageway for receiving a cable therethrough, wherein the axial passageway has a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway, the elongate member having a first end portion and a second end portion adjacent to the first end portion, wherein the cross-sectional geometry of the axial passageway through the first end portion increases in area in a direction away from the second end portion.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scism in view of Phipps (2003/0230343).

Scism discloses the invention substantially as claimed except for the second end portion comprising a tapered portion for frictionally engaging the raceway member. Phipps discloses a pipe connection comprising an elongate member (Fig. 7) comprising a second end portion (58a, 59a) having a tapered portion for frictionally engaging to another elongate member. It would have been obvious that instead of connecting the elongate member (3) and the raceway (4, Figure 4) of Scism by threading, one skilled in the art would frictionally engage, as taught by Phipps, the end portion of the elongate member and the end portion of the raceway to simplify the connection process.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scism in view of Salvaggio (5,661,263).

Scism discloses the invention substantially as claimed except for the cross-sectional geometry of the axial passageway being polygonal. Salvaggio discloses an invention relating elongate members which can be made in different shapes and have axial passageway with cross-sectional geometry being polygonal. It would have been obvious that depending on the specific use of the resulting device, one skilled in the art would modify the cross-sectional geometry of Scism to be polygonal since it is taught by Salvaggio that different shapes of the elongate members would have different effect.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scism in view of Salvaggio as applied to claim 5 above, and further in view of Phipps.

The combination of Scism and Salvaggio discloses the invention substantially as claimed except for the second end portion comprising a tapered portion for frictionally engaging the raceway. Phipps discloses a pipe connection comprising an elongate member (Fig. 7) comprising a second end portion (58a, 59a) having a tapered portion for frictionally engaging to another elongate member. It would have been obvious that instead of connecting the elongate member (3) and the raceway (4, Figure 4) of Scism by threading, one skilled in the

art would frictionally engage, as taught by Phipps, the end portion of the elongate member and the end portion of the raceway to simplify the connection process.

10. Claims 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scism.

Claims 7 and 8 in addition to the limitations of claim 1 recite the elongate member being formed of plastic or metal. It would have been obvious to one skilled in the art to either use plastic or metal for the elongate member of Scism to meet the specific use of the resulting device since both plastic and metal are known in the art for being used as elongate members. In addition, it has been held that within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Re claim 10, it would have been obvious to one skilled in the art to provide the elongate member of Scism with an axial slot so that cable can be inserted into the member without accessing the member ends since elongate member with axial slot is well-known in the art. Examiner takes Official Notice.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scism in view of Vogelsang (5,713,700).

Claim 9 additionally recites a dry film of lubricant on the axial passageway of the elongate member. Vogelsang discloses a cable system comprising a dry film of lubricant (8) being provided on an axial passageway. It would have been obvious to one skilled in the art to provide the axial passageway of Scism with a dry film of lubricant as taught by Vogelsang, to reduce the friction between the cable and the elongate member.

12. Claims 11, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scism in view of Stout, Jr.

Scism discloses a device comprising an elongate member defining an axial passageway for receiving a cable therethrough, wherein the axial passageway has a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway, the elongate member having a first end portion and a second end portion adjacent to the first end portion (re claim 11). Scism also discloses the second end portion comprising a first threaded portion and the raceway member comprising a second threaded portion thereon (re claim 12). Scism does not disclose the cross-sectional geometry of the axial passageway through the first end portion increasing in area in a direction away from the second end portion. Stout, Jr. discloses a device (Fig. 5) comprising an elongate member defining an axial

passageway having a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway, the elongate member having a first end portion and a second end portion adjacent to the first end portion, wherein the cross-sectional geometry of the axial passageway through the first end portion increases in area in a direction away from the second end portion. It would have been obvious to one skilled in the art to modify the first end portion of Scism to have an increased cross-sectional geometry as taught by Stout, Jr. so that cables can be easily accessed through the first end portion. Re claims 14 and 15, it would have been obvious that depending on the specific use of the resulting device, one skilled in the art would provide a linear (frustoconical-shaped) or non-linear (horn-shaped) increased cross-sectional geometry through the first end portion of Scism since the application has not presented that the particular configurations of the increased cross-sectional geometry are significant, and a change in size or shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 and *In re Dailey*, 149 USPQ 47.

13. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phipps in view of Stout, Jr.

Phipps discloses a device (Fig. 7) comprising an elongate member defining an axial passageway having a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway, the elongate member having a first end portion and a second end portion adjacent to the first end portion (re claim 11). Phipps also discloses the second end portion comprising a tapered portion for a frictionally engagement (re claim 13). Phipps does not disclose the cross-sectional geometry of the axial passageway through the first end portion increasing in area in a direction away from the second end portion. Stout, Jr. discloses a device (Fig. 5) comprising an elongate member defining an axial passageway having a pre-determined cross-sectional geometry in a plane perpendicular to the axial passageway, the elongate member having a first end portion and a second end portion adjacent to the first end portion, wherein the cross-sectional geometry of the axial passageway through the first end portion increases in area in a direction away from the second end portion. It would have been obvious to one skilled in the art to modify the first end portion of Phipps to have an increased cross-sectional geometry as taught by Stout, Jr. such that another tube or pipe with a large diameter can be attached to the first end portion of the device.

14. Claims 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stout, Jr.

Claims 16 and 17 in addition to the limitations of claim 11 recite the elongate member being formed of plastic or metal. It would have been obvious to one skilled in the art to either use plastic or metal for the elongate member of Stout, Jr. to meet the specific use of the resulting device since both plastic and metal are known in the art for being used as elongate members. In addition, it has been held that within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Re claim 19, it would have been obvious to one skilled in the art to provide the elongate member of Stout, Jr. with an axial slot so that one can access into the interior of the member without accessing the member ends since elongate member with axial slot is well-known in the art. Examiner takes Official Notice.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scism in view of Stout, Jr. as applied to claim 11 above, and further in view of Vogelsang.

Claim 18 additionally recites a dry film of lubricant on the axial passageway of the elongate member. Vogelsang discloses a cable system comprising a dry film of lubricant (8) being provided on an axial passageway. It would have been obvious to one skilled in the art to provide the axial passageway of Scism with a dry film of lubricant as taught by Vogelsang, to reduce the friction between the cable and the elongate member.

Cited Art

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sharp and Gregorac disclose joining tubes.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Chau N Nguyen', with a stylized, flowing script.

Chau N Nguyen
Primary Examiner
Art Unit 2831